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159. (New) The method of claim 138 wherein the return electrode is an outer tubular member defining an axial passage between the outer surface of the probe and the inner surface of the outer tubular member, the delivering step including directing the electrically conductive fluid through the axial passage to the distal end of the probe over the electrode terminal.--

REMARKS

Claims 80, 81 and 83-159 are pending. Applicant has amended claims 80, 81, 83, 90 and 99-102 to address the Examiner's 112 rejections on page 2 of the Office Action. Applicant disagrees with the Examiner's double patenting rejections on pages 4 and 5 of the Office Action. However, to expedite prosecution, applicant has amended claim 80 to address the Examiner's double patenting rejection on page 4. In addition, applicant has submitted a terminal disclaimer concurrently with this response to obviate the obviousness-type double patenting rejection on page 5 of the Office Action.

The claims stand rejected as being anticipated or obvious over Baker, Knowlton, Abele and Lax. Applicant disagrees with these rejections. None of the cited references disclose or suggest the affirmative step of positioning a return electrode within electrically conductive fluid to generate a current flow path between the active and return electrodes, as is recited in claim 80. However, to expedite prosecution, applicant has amended independent claim 80 to even more clearly distinguish over the prior art. Claim 80 now recites the step of positioning a return electrode within the electrically conductive fluid such that the return electrode is not in contact with the body structure. Baker, Abele and Lax clearly do not disclose or suggest this step. As stated in col. 3, lines 58-63 and col. 6, lines 63-66 of Baker, the return electrode must function as a grounding pad and thus is in contact with the tissue. The ablation band is formed along the tissue between the two distal ends of the electrodes, which are both in contact with the tissue. In the Abele device, the electrodes are designed to press again the heart tissue with the desired contact pressure. Similarly, the Lax device must have contact between both the active and return electrodes and the patient's tissue.

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In the Knowlton device, the thermal electrodes 26 are placed in a porous membrane 18, and an electrolytic solution 20 is introduced into the porous membrane to transfer RF current or power from RF electrodes 28 to the underlying collagen tissue (col. 5, lines 25-32). The monopolar mode is described (col. 5, lines 34-37) as having a return electrode in the form of a conductive pad applied to the patient's outer skin. The reference states that RF electrodes 26 can be monopolar or bipolar (line 33). However, the reference does not describe how a bipolar device would work to transfer the RF power to the underlying collagen tissue. For example, if electrodes 26 were both the active and return electrodes, the RF current or power would simply pass from one of the electrodes 26 through the conductive solution within membrane 18 to the other of the electrodes 26 (i.e., without transferring any RF power to the underlying tissue). Thus, even in the bipolar embodiment (which is not described), the return electrode must be in contact with the tissue in order for the RF power to be transferred thereto. Accordingly, applicant requests that this rejection be withdrawn.

New independent claim 138 recites the steps of contacting an active electrode with the body structure in the presence of an electrically conductive fluid, and spacing a return electrode away from the body structure in the presence of the electrically conductive fluid. None of the cited references disclose or suggest these two steps. In Baker, Lax and Abele, both active and return electrodes are in contact with the tissue. In Knowlton, the active electrode 26 is not in contact with the tissue.

Applicant believes that this application is now in condition for allowance. If the Examiner believes a telephone conference would expedite prosecution of this application, please telephone the undersigned at (408) 736-0224.

Respectfully submitted,

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